

Modified PTO/SB/17 (01-03)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 330.00)

Complete if Known

Application Number	09/400,034
Filing Date	September 21, 1999
First Named Inventor	Ralph K. ITO
Examiner Name	Matthew O. Savage
Art Unit	1723
Attorney Docket No.	Olympus-13

METHOD OF PAYMENT (check all that apply)

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Straub & Pokotylo

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ 00.00)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		-20** =		X		=	
Independent Claims		-3** =		X		=	
Multiple Dependent						=	

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$ 00.00)

**or number previously paid, if greater, For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(c)	
1806	180	1806	180	Submission of Information Disclosure	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
* Reduced by Basic Filing Fee Paid					
SUBTOTAL (3)					(\$ 330.00)

SUBMITTED BY

(Complete (if applicable))

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Signature		Date	December 2, 2003		

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Modified PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/400,034	
	Filing Date	September 21, 1999	
	First Named Inventor	Ralph K. ITO	
	Group Art Unit	1723	
	Examiner Name	Matthew O. Savage	
Total Number of Pages in This Submission		Attorney Docket Number	Olympus-13

ENCLOSURES <i>(check all that apply)</i>		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i>	<input type="checkbox"/> After Allowance Communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i>
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<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i>
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Firm or Individual name	John C. Pokotylo (Reg. No. 36,242)
Signature	
Date	December 2, 2003

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**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Attorney Docket No.: **Olympus-13**

Applicant: **Ralph K. ITO**

Serial No.: **09/400,034**

Filing Date: **September 21, 1999**

Title: **METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE
ALIQUOT**

Examiner: **Matthew O. Savage**

Group Art Unit: **1723**

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S I R:

APPEAL BRIEF

Further to the Notice of Appeal filed on October 2, 2003 and granted a date of receipt of October 6, 2003 by the U.S. Patent & Trademark Office, which set a period of response to expire on December 6, 2003, the applicant requests that the Board reverse all outstanding grounds of rejection in view of the following.

I. Real Party In Interest

The real party in interest is Olympus America Inc. An assignment of the above referenced patent application from the inventor to Olympus America Inc. was recorded in the Patent Office starting at Frame 0571 of Reel 010273.

II. Related Appeals and Interference

There are no related appeals or interferences.

III. Status of Claims

Claims 1-10 and 53-63 are pending and rejected.

More specifically, claims 1-10 and 53-63 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,432,366 (hereafter referred to as "the Ruediger patent").

Claims 11-13 and 28-52 have been withdrawn from consideration.

Claims 14-27 have been cancelled.

IV. Status of Amendments

All amendments have been entered. No amendments were filed subsequent to the final Office Action mailed on July 2, 2003 (Paper No. 17).

V. Summary of the Invention

The present invention concerns apparatus for preparing a fluid sample. The apparatus may include a first part and a second part. (See, e.g., Figures 5A-5C.) The first part (See, e.g., 100 of Figure 1.) may include a pipette tip having an open tip end (See, e.g., 110 and 112 of Figure 1.), and a sample cup, fluidly coupled with the pipette tip and having an open end (See, e.g., 120, 122 of Figure 1.). The second part (See, e.g., 200 of Figure 2.) may include a channel for receiving the pipette tip of the first part, a support for accommodating at least a portion of the sample cup of the first part (See, e.g., Figure 5C.), and a constricted passage, arranged between the channel and the

support (See, e.g., 220 of Figure 2.), for collapsing the pipette tip of the first part as the first part is inserted into the second part. The pipette tip of the first part and the constricted passage of the second part may be designed (i) such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, (ii) such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal such that liquid in the pipette tip of the first part is forced upward into the sample cup of the first part, (iii) such that a moving liquid seal progresses up the pipette tip as the pipette tip passes through the constricted passage, or (iv) such that the moving liquid seal progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the moving liquid seal forces liquid in the pipette tip upward into the sample cup. (See, e.g., page 7, line 28 through page 8, line 6, and Figures 5A-5C.)

The pipette tip may be formed of a flexible and collapsible material. (See, e.g., page 6, lines 28-31.) The pipette tip may be tapered. (See, e.g., 110 of Figure 1.) The open end of the sample cup of the first part may be dimensioned to mate with an automated pipetting system. (See, e.g., page 7, lines 4-8.)

The length of the channel of the second part may be at least as long as a length of the pipette tip of the first part. (See, e.g., page 11, lines 15-19.) The support of the second part may be shaped to match a bottom of the sample cup of the first part. (See, e.g., page 7, lines 14-19.) The support of the second part may be shaped to guide the pipette tip of the first part to the constricted

passage of the second part as the first part is inserted into the second part. The support of the second part may be tapered or shaped as a funnel. (See, e.g., page 7, lines 14-23.) The constricted passage may have a fixed cross section. (See, e.g., 220 of Figure 2.)

VI. Issues

The issue presented for review is whether (separately patentable groups of) claims 1-10 and 53-60 are anticipated, under 35 U.S.C. § 102, by the Ruediger patent.

VII. Grouping of Claims

The claims do not stand or fall together.

For purposes of this Appeal, Appellant proposes the following grouping of claims:

Group I: Claims 1, 2, 3 and 5-8 are grouped together with claim 1 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Accordingly, claims 1, 2, 3 and 5-8 stand together.

Group II: Claim 4 is included in Group II. Although claim 4 is subject to the same rejection as the claims of Group I, this claim is separately patentable because it further specifies that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly **and form a liquid seal.**

Group III: Claims 9 and 10 are grouped together with claim 9 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group III are subject to the same rejection as the claims of Groups I and II, these claims are separately patentable because they further specify that the support of the second part is shaped as a funnel or is tapered.

Group IV: Claim 53 is included in Group IV. Although claim 53 is subject to the same rejection as the claims of Groups I-III, this claim is separately patentable because it further specifies that the pipette tip is tapered.

Group V: Claim 54 is included in Group V. Although claim 54 is subject to the same rejection as the claims of Groups I-IV, this claim is separately patentable because it further specifies that the constricted passage has a fixed cross section.

Group VI: Claims 55-57 are grouped together with claim 57 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VI are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the

constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup.

Group VII: Claims 58-60 are grouped together with claim 60 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VII are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. Although the claims of Group VII are subject to the same rejection as the claims of Group VI, these claims are separately patentable because they further specify that the pipette tip is tapered (by virtue of their dependence from claim 53 of Group IV).

Group VIII: Claims 61-63 are grouped together with claim 63 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VIII are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining

the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. Although the claims of Group VIII are subject to the same rejection as the claims of Groups VI and VII, these claims are separately patentable because they further specify that the constricted passage has a fixed cross section (by virtue of their dependence from claim 54 of Group V).

VII. Argument

The applicant respectfully requests that the Board reverse the final rejection of claims 1-10 and 53-63 in view of the following.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-10 and 53-63 stand rejected under 35 U.S.C. § 102 as being anticipated by the Ruediger patent. The applicant respectfully requests that the Board reverse this ground of rejection in view of the following. Separate groups are addressed separately.

Group I: Claims 1, 2, 3 and 5-8

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part**. Claim 1 is reprinted below with this feature depicted in bold typeface:

1. An apparatus for preparing a fluid sample, the apparatus comprising:
 - a) a first part including
 - i) a pipette tip having an open tip end, and
 - ii) a sample cup, fluidly coupled with the pipette tip and having an open end; and
 - b) a second part including
 - i) a channel for receiving the pipette tip of the first part,
 - ii) a support for accommodating at least a portion of the sample cup of the first part, and
 - iii) **a constricted passage, arranged between the channel and the support, for collapsing the pipette tip of the first part as the first part is inserted into the second part.** [Emphasis added.]

This feature is discussed below. First, however, the Ruediger patent is described.

The most relevant part of the Ruediger patent describes a valve block C used to dispense, or not dispense, fluid from reactor vessels 10, via outlet tubes 52, into wells 12 of a collection block D. (See, e.g., Figure 1 and column 8, lines 43-51.) Leur tip adapters 56 are used to fluidly couple the reactor vessels 10 with outlet tubes 54. (See, e.g., column 9, lines 48-55 and Figure 4.) More specifically, as shown in Figures 4, 6 and 8, as a slide 44 is moved by a threaded screw 74, each of its spaced, downwardly extending, ribs 66 force a resilient member 68 into an outlet tube 54 arranged between it and a corresponding upward extending rib 62 of a bottom plate 40. This structure operates to form a "pinch valve". (See,

e.g., column 9, line 39 through column 10, line 55.) As can be appreciated from this disclosure, as well as reference to Figures 6 and 8, the outlet tube 54 is pinched after it has already been situated. (See, e.g., column 10, lines 6-10.)

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part.** As discussed above, in the Ruediger patent, an outlet tube 54 is pinched after its has already been situated--it is not collapsed as it is inserted. Thus, independent claim 1 is not anticipated by the Ruediger patent for at least this reason. Since claims 2, 3 and 5-8 depend from claim 1, they are similarly not anticipated by the Ruediger patent for at least this reason.

The applicant notes that the Examiner stated that the Ruediger patent is "capable of" collapsing the tube 54 as it is inserted into parts 40, 79 and 82. (See Paper No. 13, page 2.) (The Examiner made a similar argument with respect to dependent claim 4.) More recently, the Examiner contends that a constricted passage (defined by 62 and 68) is:

capable of collapsing the pipette tip as the first part is inserted into the second part in any of three modes as follows: 1) collapsing part 54 between parts 62 and 68 after it has been fully received within parts 39, 40, and 44 as shown in FIG.8; 2) partially inserting part 54 into parts 39, 40, and 44, collapsing the tube between parts 62 and 68, and then fully axially

inserting part 54 into parts 39, 40, and 44; [and 3)] partially or fully closing the gap between parts 62 and 68 with the screw operated adjustment mechanism 42 shown in FIG. 1 followed by fully axially inserting part 54 into parts 39, 40, and 44.

(Paper No. 17, pages 2 and 3.) The Examiner's arguments are both unsubstantiated and irrelevant as a matter of law.

Although mode (1) proposed by the Examiner is described in the Ruediger patent, it does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part**. To reiterate, in the Ruediger patent, the outlet tube 54 is pinched **after** it has already been situated. That is, although the Ruediger patent teaches this mode (1), it fails to teach the foregoing recitation in claim 1.

The Examiner's assertions that the Ruediger patent teaches second and third modes (2) and (3) are unsubstantiated, and these modes are not inherent. Finally, even assuming, arguendo, that the Ruediger patent could be adjusted as proposed by the Examiner, this is insufficient to support anticipation. Each of the two modes is addressed.

In mode (2) proposed by the Examiner, part 54 is partially inserted into parts 39, 40, and 44, the tube is collapsed between parts 62 and 68, and then the part 54 is fully axially inserted into parts 39, 40, and 44. In mode (3) proposed by the Examiner, the gap between parts 62 and 68 is partially or fully closed (with the screw operated adjustment mechanism 42 shown in FIG. 1) and then part 54 is fully axially inserted into parts 39, 40, and 44. There

is nothing to show that the Ruediger patent has these capabilities. The only operating mode described in the Ruediger patent is after the part 54 is fully inserted into assembly 39, 40, 44, pinching the part 54 to stop fluid flow, or opening the plates such that discharge of fluids through outlet tubes 54 is unimpeded. The operation of screw 76 through end cap 42, with slide plate 44 to pinch close open tube 54 is described in Column 10, lines 37-55. Notably, this passage states that, "Overtightening of the plates and crushing or deformation of the tubes is prevented by this structure while complete closure of all tubes is insured when the valve is closed." Column 10, lines 52-55. As can be appreciated from the foregoing, not only are modes (2) and (3) proposed by the Examiner unsubstantiated, it is clear that one skilled in the art would not read the Ruediger patent as necessarily including these modes.

More importantly, even if the Ruediger patent was **capable** of collapsing the tube 54 as it is inserted into parts 40, 79 and 82, the Supreme Court has held that prior devices capable of being adjusted so as to operate in the same manner as a patented device did not anticipate that patented device (Clough v. Gilbert & Baker Mfg., 106 U.S. 166 (1882)) and that a prior device capable of slight modification so as to operate in the same manner as the patented device did not anticipate that patented device (Topliff v. Topliff, 145 U.S. 156 (1892)). Accordingly, even assuming, arguendo, that the Ruediger patent were **capable** of doing what the Examiner contends, such a capability would be immaterial to the question of whether or not it anticipates claim 1.

The rejection relies on a relaxed version of inherency, which is at odds with well-established law. As the Court of Appeals for the Federal Circuit ("the CAFC") has stated, "Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In a very relevant case, the CAFC found that a prior art inventor's testimony as to what his patent was capable of doing was irrelevant for purposes of using that patent in an anticipation rejection. More specifically, in Transclean Corp. v. Bridgewood Services Inc., 62 U.S.P.Q.2d 1865 (Fed. Cir. 2002), the CAFC stated:

[The accused infringer] Bridgewood presented testimony from Becnel, the inventor, that his invention **could be operated in such a manner as to equalize flow rates**. However, as the district court found, **that manner is not disclosed in the Becnel patent itself, nor is it inherent in the operation of Becnel's invention**. Summary Judgment Opinion at 1081 ("Becnel was able to read the fluid gauges, and then manually adjust the flow of fresh fluid so as to equalize the fluid flows, but **neither his declaration, nor [Bridgewood's patent expert's] opinion, offer any explanation as to how a person of ordinary skill would read the Becnel Patent specification, and recognize that this method of flow equalization is necessarily present in the embodiment disclosed** in Fig. 5.>"). We conclude, as did the district court, that Bridgewood did not raise any genuine issue of material fact regarding anticipation of claim 1 by

the Becnel patent. Accordingly, we affirm the court's conclusion that Transclean is entitled to summary judgment of non-anticipation as to the Becnel patent. [Emphasis added.]

Id., at 1871.

As can be appreciated from the foregoing, the Ruediger patent does not disclose the recitations of claim 1, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or "could be" adjusted in a certain manner are both unsubstantiated, and irrelevant to the issue of anticipation even if true.

In view of the foregoing, claim 1 is not anticipated by the Ruediger patent for at least this reason. Since claims 2, 3 and 5-8 depend from claim 1, they are similarly not anticipated by the Ruediger patent.

Group II: Claim 4

Claim 4 is not anticipated by the Ruediger patent because the Ruediger patent does not include a pipette tip and constricted passage designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly to form a liquid seal. The Examiner argues that the Ruediger patent **is capable of** functioning in this way, citing modes (2) and (3) proposed by the Examiner. (See Paper No. 17, page 3.) However, as was the case of the application of the Ruediger patent to claim 1 above, the Ruediger patent does not disclose the recitations of claim 4, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or

"could be" adjusted in a certain manner are both unsubstantiated, and irrelevant to the issue of anticipation even if true. The claim of Group II is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group III: Claims 9 and 10

Claims 9 and 10 are not anticipated by the Ruediger patent because the Ruediger patent does not disclose a support of a second part that is shaped as a funnel or is tapered, where the support of the second part is for accommodating at least a portion of the sample cup of the first part. The Examiner argues that support 44 of the Ruediger patent is funnel shaped or tapered. (See Paper No. 17, page 3.) Even assuming, arguendo, that the "holes with flared ends" 64 in the plate 44 can be considered tapered, they are not a support for accommodating at least a portion of a sample cup of a first part. More specifically, in his rejection of claim 1, the Examiner argued that part 39 of the Ruediger patent describes a support for accommodating a sample cup, which the Examiner argues is taught by Leur tip adapter 56 of the Ruediger patent. Thus, the Examiner proffers two contradictory arguments. If, on the one hand, the Examiner's position is that element 39 is the support, it is clearly not tapered or funnel-shaped. If, on the other hand, the Examiner's position is that element 44 is the support, then it does not support the purported sample cup 56. The claims of Group III are therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group IV: Claim 53

Claim 53 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a pipette tip that is tapered. Here again, the Examiner proffers two contradictory arguments. In his rejection of claim 1, the Examiner argues that element 54 of the Ruediger patent is the claimed pipette tip, while elements 10 and 56 are sample cups. (See Paper No. 17, page 2.) As shown in Figures 6 and 8-10, element 54 is not tapered. Later, in his rejection of claim 53, the Examiner argues that element 56 (which he previously called a sample cup) is the pipette tip that is tapered. If, on the one hand, the Examiner's position is that element 54 is the pipette tip, then it is clearly not tapered. If, on the other hand, the Examiner's position is that Leur tip adapter 56 is a the pipette tip, (as well as a sample cup) then it is clearly not collapsed as it is inserted into a constricted passage. The claim of Group IV is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group V: Claim 54

Claim 54 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a constricted passage having a fixed cross section. The Examiner contends that the constricted passage (defined by plates 40 and 44 and resilient members 68) has a fixed cross section after the pipette tube had been fully collapsed. (Paper No. 17, page 4.) Even assuming, arguendo, that the passage in the Ruediger patent can be assume a particular state at a give point in time, such a state is temporary, not fixed.

The fact that plates 40 and 44 slide with respect with one another to change the cross section is clearly illustrated in Figures 6 and 8 and described, for example at column 10, lines 37-55. If the cross section were to be fixed, the utility of the Ruediger patent as an array of pinch valves would be destroyed and, two separate plates wouldn't be needed. In any event, as Figures 6 and 8 illustrate, the cross section of the passage is clearly not fixed. The claim of Group V is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group VI: Claims 55-57

Claims 55-57 are not anticipated by the Ruediger patent because the Ruediger patent does not disclose that a pipette tip of a first part and a constricted passage of a second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. The Examiner argues that the Ruediger patent is "capable of" functioning in this way, noting the modes (2) and (3) proposed by the Examiner. (See Paper No. 17, page 4.) However, as was the case of the application of the Ruediger patent to claims 1 and 4 above, the Ruediger patent does not disclose the recitations of the claims of this group, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or "could be" adjusted in a certain manner are both

unsubstantiated, and irrelevant to the issue of anticipation even if true. The claims of Group VI are therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group VII: Claims 58-60

The claims of Group VII are allowable for the reasons addressed above with respect to the claims of Groups I, IV and VI.

Group VIII: Claims 61-63

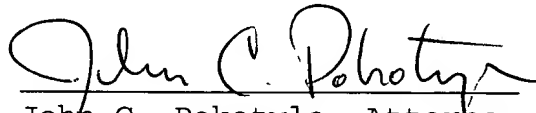
The claims of Group VIII are allowable for the reasons addressed above with respect to the claims of Groups I, V and VI.

Conclusion

In view of the foregoing, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

December 2, 2003



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John C. Pokotylo

36,242
Reg. No.

APPENDIX

1 1. An apparatus for preparing a fluid sample, the
2 apparatus comprising:

3 a) a first part including

4 i) a pipette tip having an open tip end, and

5 ii) a sample cup, fluidly coupled with the
6 pipette tip and having an open end; and

7 b) a second part including

8 i) a channel for receiving the pipette tip of
9 the first part,

10 ii) a support for accommodating at least a
11 portion of the sample cup of the first part, and

12 iii) a constricted passage, arranged between the
13 channel and the support, for collapsing the
14 pipette tip of the first part as the first part
15 is inserted into the second part.

1 2. The apparatus of claim 1 wherein the pipette tip is
2 formed of a collapsible material.

1 3. The apparatus of claim 1 wherein the pipette tip is
2 formed of a flexible and collapsible material.

1 4. The apparatus of claim 1 wherein the pipette tip of the
2 first part and the constricted passage of the second part
3 are designed such that, as the pipette tip passes through
4 the constricted passage, walls defining the pipette tip
5 collapse inwardly and form a liquid seal.

1 5. The apparatus of claim 1 wherein a length of the
2 channel of the second part is at least as long as a length
3 of the pipette tip of the first part.

1 6. The apparatus of claim 1 wherein the open end of the
2 sample cup of the first part is dimensioned to mate with an
3 automated pipetting system.

1 7. The apparatus of claim 1 wherein the support of the
2 second part is shaped to match a bottom of the sample cup
3 of the first part.

1 8. The apparatus of claim 1 wherein the support of the
2 second part is shaped to guide the pipette tip of the first
3 part to the constricted passage of the second part as the
4 first part is inserted into the second part.

1 9. The apparatus of claim 1 wherein the support of the
2 second part is shaped as a funnel.

1 10. The apparatus of claim 1 wherein the support of the
2 second part is tapered.

1 53. The apparatus of claim 1 wherein the pipette tip is
2 tapered.

1 54. The apparatus of claim 1 wherein the constricted
2 passage has a fixed cross section.

1 55. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 56. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette

5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 57. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.

1 58. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 59. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second

3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 60. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.

1 61. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 62. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 63. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.



**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Attorney Docket No.: **Olympus-13**

Applicant: **Ralph K. ITO**

Serial No.: **09/400,034**

Filing Date: **September 21, 1999**

Title: **METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE
ALIQUOT**

Examiner: **Matthew O. Savage**

Group Art Unit: **1723**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

APPEAL BRIEF

Further to the Notice of Appeal filed on October 2, 2003 and granted a date of receipt of October 6, 2003 by the U.S. Patent & Trademark Office, which set a period of response to expire on December 6, 2003, the applicant requests that the Board reverse all outstanding grounds of rejection in view of the following.

I. Real Party In Interest

The real party in interest is Olympus America Inc. An assignment of the above referenced patent application from the inventor to Olympus America Inc. was recorded in the Patent Office starting at Frame 0571 of Reel 010273.

II. Related Appeals and Interference

There are no related appeals or interferences.

III. Status of Claims

Claims 1-10 and 53-63 are pending and rejected.

More specifically, claims 1-10 and 53-63 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,432,366 (hereafter referred to as "the Ruediger patent").

Claims 11-13 and 28-52 have been withdrawn from consideration.

Claims 14-27 have been cancelled.

IV. Status of Amendments

All amendments have been entered. No amendments were filed subsequent to the final Office Action mailed on July 2, 2003 (Paper No. 17).

V. Summary of the Invention

The present invention concerns apparatus for preparing a fluid sample. The apparatus may include a first part and a second part. (See, e.g., Figures 5A-5C.) The first part (See, e.g., 100 of Figure 1.) may include a pipette tip having an open tip end (See, e.g., 110 and 112 of Figure 1.), and a sample cup, fluidly coupled with the pipette tip and having an open end (See, e.g., 120, 122 of Figure 1.). The second part (See, e.g., 200 of Figure 2.) may include a channel for receiving the pipette tip of the first part, a support for accommodating at least a portion of the sample cup of the first part (See, e.g., Figure 5C.), and a constricted passage, arranged between the channel and the

support (See, e.g., 220 of Figure 2.), for collapsing the pipette tip of the first part as the first part is inserted into the second part. The pipette tip of the first part and the constricted passage of the second part may be designed (i) such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, (ii) such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal such that liquid in the pipette tip of the first part is forced upward into the sample cup of the first part, (iii) such that a moving liquid seal progresses up the pipette tip as the pipette tip passes through the constricted passage, or (iv) such that the moving liquid seal progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the moving liquid seal forces liquid in the pipette tip upward into the sample cup. (See, e.g., page 7, line 28 through page 8, line 6, and Figures 5A-5C.)

The pipette tip may be formed of a flexible and collapsible material. (See, e.g., page 6, lines 28-31.) The pipette tip may be tapered. (See, e.g., 110 of Figure 1.) The open end of the sample cup of the first part may be dimensioned to mate with an automated pipetting system. (See, e.g., page 7, lines 4-8.)

The length of the channel of the second part may be at least as long as a length of the pipette tip of the first part. (See, e.g., page 11, lines 15-19.) The support of the second part may be shaped to match a bottom of the sample cup of the first part. (See, e.g., page 7, lines 14-19.) The support of the second part may be shaped to guide the pipette tip of the first part to the constricted

passage of the second part as the first part is inserted into the second part. The support of the second part may be tapered or shaped as a funnel. (See, e.g., page 7, lines 14-23.) The constricted passage may have a fixed cross section. (See, e.g., 220 of Figure 2.)

VI. Issues

The issue presented for review is whether (separately patentable groups of) claims 1-10 and 53-60 are anticipated, under 35 U.S.C. § 102, by the Ruediger patent.

VII. Grouping of Claims

The claims do not stand or fall together.

For purposes of this Appeal, Appellant proposes the following grouping of claims:

Group I: Claims 1, 2, 3 and 5-8 are grouped together with claim 1 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Accordingly, claims 1, 2, 3 and 5-8 stand together.

Group II: Claim 4 is included in Group II. Although claim 4 is subject to the same rejection as the claims of Group I, this claim is separately patentable because it further specifies that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal.

Group III: Claims 9 and 10 are grouped together with claim 9 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group III are subject to the same rejection as the claims of Groups I and II, these claims are separately patentable because they further specify that the support of the second part is shaped as a funnel or is tapered.

Group IV: Claim 53 is included in Group IV. Although claim 53 is subject to the same rejection as the claims of Groups I-III, this claim is separately patentable because it further specifies that the pipette tip is tapered.

Group V: Claim 54 is included in Group V. Although claim 54 is subject to the same rejection as the claims of Groups I-IV, this claim is separately patentable because it further specifies that the constricted passage has a fixed cross section.

Group VI: Claims 55-57 are grouped together with claim 57 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VI are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the

constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup.

Group VII: Claims 58-60 are grouped together with claim 60 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VII are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. Although the claims of Group VII are subject to the same rejection as the claims of Group VI, these claims are separately patentable because they further specify that the pipette tip is tapered (by virtue of their dependence from claim 53 of Group IV).

Group VIII: Claims 61-63 are grouped together with claim 63 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. Although the claims of Group VIII are subject to the same rejection as the claims of Groups I-V, these claims are separately patentable because they further specify that the pipette tip of the first part and the constricted passage of the second part are designed such that, as the pipette tip passes through the constricted passage, walls defining

the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. Although the claims of Group VIII are subject to the same rejection as the claims of Groups VI and VII, these claims are separately patentable because they further specify that the constricted passage has a fixed cross section (by virtue of their dependence from claim 54 of Group V).

VII. Argument

The applicant respectfully requests that the Board reverse the final rejection of claims 1-10 and 53-63 in view of the following.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-10 and 53-63 stand rejected under 35 U.S.C. § 102 as being anticipated by the Ruediger patent. The applicant respectfully requests that the Board reverse this ground of rejection in view of the following. Separate groups are addressed separately.

Group I: Claims 1, 2, 3 and 5-8

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part**. Claim 1 is reprinted below with this feature depicted in bold typeface:

1. An apparatus for preparing a fluid sample, the apparatus comprising:

- a) a first part including
 - i) a pipette tip having an open tip end, and
 - ii) a sample cup, fluidly coupled with the pipette tip and having an open end; and
- b) a second part including
 - i) a channel for receiving the pipette tip of the first part,
 - ii) a support for accommodating at least a portion of the sample cup of the first part, and
 - iii) **a constricted passage, arranged between the channel and the support, for collapsing the pipette tip of the first part as the first part is inserted into the second part.** [Emphasis added.]

This feature is discussed below. First, however, the Ruediger patent is described.

The most relevant part of the Ruediger patent describes a valve block C used to dispense, or not dispense, fluid from reactor vessels 10, via outlet tubes 52, into wells 12 of a collection block D. (See, e.g., Figure 1 and column 8, lines 43-51.) Leur tip adapters 56 are used to fluidly couple the reactor vessels 10 with outlet tubes 54. (See, e.g., column 9, lines 48-55 and Figure 4.) More specifically, as shown in Figures 4, 6 and 8, as a slide 44 is moved by a threaded screw 74, each of its spaced, downwardly extending, ribs 66 force a resilient member 68 into an outlet tube 54 arranged between it and a corresponding upward extending rib 62 of a bottom plate 40. This structure operates to form a "pinch valve". (See,

e.g., column 9, line 39 through column 10, line 55.) As can be appreciated from this disclosure, as well as reference to Figures 6 and 8, the outlet tube 54 is pinched **after** it has already been situated. (See, e.g., column 10, lines 6-10.)

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part.** As discussed above, in the Ruediger patent, an outlet tube 54 is pinched after its has already been situated--it is not collapsed as it is inserted. Thus, independent claim 1 is not anticipated by the Ruediger patent for at least this reason. Since claims 2, 3 and 5-8 depend from claim 1, they are similarly not anticipated by the Ruediger patent for at least this reason.

The applicant notes that the Examiner stated that the Ruediger patent is "capable of" collapsing the tube 54 as it is inserted into parts 40, 79 and 82. (See Paper No. 13, page 2.) (The Examiner made a similar argument with respect to dependent claim 4.) More recently, the Examiner contends that a constricted passage (defined by 62 and 68) is:

capable of collapsing the pipette tip as the first part is inserted into the second part in any of three modes as follows: 1) collapsing part 54 between parts 62 and 68 after it has been fully received within parts 39, 40, and 44 as shown in FIG.8; 2) partially inserting part 54 into parts 39, 40, and 44, collapsing the tube between parts 62 and 68, and then fully axially

inserting part 54 into parts 39, 40, and 44; [and 3)] partially or fully closing the gap between parts 62 and 68 with the screw operated adjustment mechanism 42 shown in FIG. 1 followed by fully axially inserting part 54 into parts 39, 40, and 44.

(Paper No. 17, pages 2 and 3.) The Examiner's arguments are both unsubstantiated and irrelevant as a matter of law.

Although mode (1) proposed by the Examiner is described in the Ruediger patent, it does not teach a **constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part**. To reiterate, in the Ruediger patent, the outlet tube 54 is pinched **after** it has already been situated. That is, although the Ruediger patent teaches this mode (1), it fails to teach the foregoing recitation in claim 1.

The Examiner's assertions that the Ruediger patent teaches second and third modes (2) and (3) are unsubstantiated, and these modes are not inherent. Finally, even assuming, arguendo, that the Ruediger patent could be adjusted as proposed by the Examiner, this is insufficient to support anticipation. Each of the two modes is addressed.

In mode (2) proposed by the Examiner, part 54 is partially inserted into parts 39, 40, and 44, the tube is collapsed between parts 62 and 68, and then the part 54 is fully axially inserted into parts 39, 40, and 44. In mode (3) proposed by the Examiner, the gap between parts 62 and 68 is partially or fully closed (with the screw operated adjustment mechanism 42 shown in FIG. 1) and then part 54 is fully axially inserted into parts 39, 40, and 44. There

is nothing to show that the Ruediger patent has these capabilities. The only operating mode described in the Ruediger patent is after the part 54 is fully inserted into assembly 39, 40, 44, pinching the part 54 to stop fluid flow, or opening the plates such that discharge of fluids through outlet tubes 54 is unimpeded. The operation of screw 76 through end cap 42, with slide plate 44 to pinch close open tube 54 is described in Column 10, lines 37-55. Notably, this passage states that, "Overtightening of the plates and crushing or deformation of the tubes is prevented by this structure while complete closure of all tubes is insured when the valve is closed." Column 10, lines 52-55. As can be appreciated from the foregoing, not only are modes (2) and (3) proposed by the Examiner unsubstantiated, it is clear that one skilled in the art would not read the Ruediger patent as necessarily including these modes.

More importantly, even if the Ruediger patent was **capable** of collapsing the tube 54 as it is inserted into parts 40, 79 and 82, the Supreme Court has held that prior devices capable of being adjusted so as to operate in the same manner as a patented device did not anticipate that patented device (Clough v. Gilbert & Baker Mfg., 106 U.S. 166 (1882)) and that a prior device capable of slight modification so as to operate in the same manner as the patented device did not anticipate that patented device (Topliff v. Topliff, 145 U.S. 156 (1892)). Accordingly, even assuming, arguendo, that the Ruediger patent were **capable** of doing what the Examiner contends, such a capability would be immaterial to the question of whether or not it anticipates claim 1.

The rejection relies on a relaxed version of inherency, which is at odds with well-established law. As the Court of Appeals for the Federal Circuit ("the CAFC") has stated, "Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In a very relevant case, the CAFC found that a prior art inventor's testimony as to what his patent was capable of doing was irrelevant for purposes of using that patent in an anticipation rejection. More specifically, in Transclean Corp. v. Bridgewood Services Inc., 62 U.S.P.Q.2d 1865 (Fed. Cir. 2002), the CAFC stated:

[The accused infringer] Bridgewood presented testimony from Becnel, the inventor, that his invention **could be operated in such a manner as to equalize flow rates**. However, as the district court found, **that manner is not disclosed in the Becnel patent itself, nor is it inherent in the operation of Becnel's invention**. Summary Judgment Opinion at 1081 ("Becnel was able to read the fluid gauges, and then manually adjust the flow of fresh fluid so as to equalize the fluid flows, but **neither his declaration, nor [Bridgewood's patent expert's] opinion, offer any explanation as to how a person of ordinary skill would read the Becnel Patent specification, and recognize that this method of flow equalization is necessarily present in the embodiment disclosed in Fig. 5.**"). We conclude, as did the district court, that Bridgewood did not raise any genuine issue of material fact regarding anticipation of claim 1 by

the Becnel patent. Accordingly, we affirm the court's conclusion that Transclean is entitled to summary judgment of non-anticipation as to the Becnel patent. [Emphasis added.]

Id., at 1871.

As can be appreciated from the foregoing, the Ruediger patent does not disclose the recitations of claim 1, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or "could be" adjusted in a certain manner are both unsubstantiated, and irrelevant to the issue of anticipation even if true.

In view of the foregoing, claim 1 is not anticipated by the Ruediger patent for at least this reason. Since claims 2, 3 and 5-8 depend from claim 1, they are similarly not anticipated by the Ruediger patent.

Group II: Claim 4

Claim 4 is not anticipated by the Ruediger patent because the Ruediger patent does not include a pipette tip and constricted passage designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly to form a liquid seal. The Examiner argues that the Ruediger patent **is capable of** functioning in this way, citing modes (2) and (3) proposed by the Examiner. (See Paper No. 17, page 3.) However, as was the case of the application of the Ruediger patent to claim 1 above, the Ruediger patent does not disclose the recitations of claim 4, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or

"could be" adjusted in a certain manner are both unsubstantiated, and irrelevant to the issue of anticipation even if true. The claim of Group II is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group III: Claims 9 and 10

Claims 9 and 10 are not anticipated by the Ruediger patent because the Ruediger patent does not disclose a support of a second part that is shaped as a funnel or is tapered, where the support of the second part is for accommodating at least a portion of the sample cup of the first part. The Examiner argues that support 44 of the Ruediger patent is funnel shaped or tapered. (See Paper No. 17, page 3.) Even assuming, arguendo, that the "holes with flared ends" 64 in the plate 44 can be considered tapered, they are not a support for accommodating at least a portion of a sample cup of a first part. More specifically, in his rejection of claim 1, the Examiner argued that part 39 of the Ruediger patent describes a support for accommodating a sample cup, which the Examiner argues is taught by Leur tip adapter 56 of the Ruediger patent. Thus, the Examiner proffers two contradictory arguments. If, on the one hand, the Examiner's position is that element 39 is the support, it is clearly not tapered or funnel-shaped. If, on the other hand, the Examiner's position is that element 44 is the support, then it does not support the purported sample cup 56. The claims of Group III are therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group IV: Claim 53

Claim 53 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a pipette tip that is tapered. Here again, the Examiner proffers two contradictory arguments. In his rejection of claim 1, the Examiner argues that element 54 of the Ruediger patent is the claimed pipette tip, while elements 10 and 56 are sample cups. (See Paper No. 17, page 2.) As shown in Figures 6 and 8-10, element 54 is not tapered. Later, in his rejection of claim 53, the Examiner argues that element 56 (which he previously called a sample cup) is the pipette tip that is tapered. If, on the one hand, the Examiner's position is that element 54 is the pipette tip, then it is clearly not tapered. If, on the other hand, the Examiner's position is that Leur tip adapter 56 is a the pipette tip, (as well as a sample cup) then it is clearly not collapsed as it is inserted into a constricted passage. The claim of Group IV is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group V: Claim 54

Claim 54 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a constricted passage having a fixed cross section. The Examiner contends that the constricted passage (defined by plates 40 and 44 and resilient members 68) has a fixed cross section after the pipette tube had been fully collapsed. (Paper No. 17, page 4.) Even assuming, arguendo, that the passage in the Ruediger patent can be assume a particular state at a give point in time, such a state is temporary, not fixed.

The fact that plates 40 and 44 slide with respect with one another to change the cross section is clearly illustrated in Figures 6 and 8 and described, for example at column 10, lines 37-55. If the cross section were to be fixed, the utility of the Ruediger patent as an array of pinch valves would be destroyed and, two separate plates wouldn't be needed. In any event, as Figures 6 and 8 illustrate, the cross section of the passage is clearly not fixed. The claim of Group V is therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group VI: Claims 55-57

Claims 55-57 are not anticipated by the Ruediger patent because the Ruediger patent does not disclose that a pipette tip of a first part and a constricted passage of a second part are designed such that, as the pipette tip passes through the constricted passage, walls defining the pipette tip collapse inwardly and form a liquid seal, such as a moving liquid seal which progresses up the pipette tip as the pipette tip passes through the constricted passage, wherein the liquid seal forces liquid in the pipette tip upward into the sample cup. The Examiner argues that the Ruediger patent is "capable of" functioning in this way, noting the modes (2) and (3) proposed by the Examiner. (See Paper No. 17, page 4.) However, as was the case of the application of the Ruediger patent to claims 1 and 4 above, the Ruediger patent does not disclose the recitations of the claims of this group, nor are those recitations inherent. The Examiner's arguments that the Ruediger patent "is capable" of certain operations, or "could be" adjusted in a certain manner are both

unsubstantiated, and irrelevant to the issue of anticipation even if true. The claims of Group VI are therefore allowable for this reason in addition to the reasons addressed above with respect to the claims of Group I.

Group VII: Claims 58-60

The claims of Group VII are allowable for the reasons addressed above with respect to the claims of Groups I, IV and VI.

Group VIII: Claims 61-63

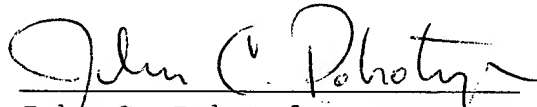
The claims of Group VIII are allowable for the reasons addressed above with respect to the claims of Groups I, V and VI.

Conclusion

In view of the foregoing, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

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APPENDIX

- 1 1. An apparatus for preparing a fluid sample, the
2 apparatus comprising:
 - 3 a) a first part including
 - 4 i) a pipette tip having an open tip end, and
 - 5 ii) a sample cup, fluidly coupled with the
6 pipette tip and having an open end; and
 - 7 b) a second part including
 - 8 i) a channel for receiving the pipette tip of
9 the first part,
 - 10 ii) a support for accommodating at least a
11 portion of the sample cup of the first part, and
 - 12 iii) a constricted passage, arranged between the
13 channel and the support, for collapsing the
14 pipette tip of the first part as the first part
15 is inserted into the second part.

- 1 2. The apparatus of claim 1 wherein the pipette tip is
2 formed of a collapsible material.

- 1 3. The apparatus of claim 1 wherein the pipette tip is
2 formed of a flexible and collapsible material.

1 4. The apparatus of claim 1 wherein the pipette tip of the
2 first part and the constricted passage of the second part
3 are designed such that, as the pipette tip passes through
4 the constricted passage, walls defining the pipette tip
5 collapse inwardly and form a liquid seal.

1 5. The apparatus of claim 1 wherein a length of the
2 channel of the second part is at least as long as a length
3 of the pipette tip of the first part.

1 6. The apparatus of claim 1 wherein the open end of the
2 sample cup of the first part is dimensioned to mate with an
3 automated pipetting system.

1 7. The apparatus of claim 1 wherein the support of the
2 second part is shaped to match a bottom of the sample cup
3 of the first part.

1 8. The apparatus of claim 1 wherein the support of the
2 second part is shaped to guide the pipette tip of the first
3 part to the constricted passage of the second part as the
4 first part is inserted into the second part.

1 9. The apparatus of claim 1 wherein the support of the
2 second part is shaped as a funnel.

1 10. The apparatus of claim 1 wherein the support of the
2 second part is tapered.

1 53. The apparatus of claim 1 wherein the pipette tip is
2 tapered.

1 54. The apparatus of claim 1 wherein the constricted
2 passage has a fixed cross section.

1 55. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 56. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette

5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 57. The apparatus of claim 1 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.

1 58. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 59. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second

3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 60. The apparatus of claim 53 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.

1 61. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a liquid seal such that
6 liquid in the pipette tip of the first part is forced
7 upward into the sample cup of the first part.

1 62. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage.

1 63. The apparatus of claim 54 wherein the pipette tip of
2 the first part and the constricted passage of the second
3 part are designed such that, as the pipette tip passes
4 through the constricted passage, walls defining the pipette
5 tip collapse inwardly and form a moving liquid seal such
6 that the moving liquid seal progresses up the pipette tip
7 as the pipette tip passes through the constricted passage,
8 wherein the moving liquid seal forces liquid in the pipette
9 tip upward into the sample cup.